

REMARKS

The pending final Office Action addresses claims 1-37 and 39, however claims 7, 14, 30, and 35 are withdrawn from consideration. Claims 1-6, 8-11, 13, 15-29, 31-34, 36, 37, and 39 stand rejected, and claim 12 is objected to.

Rejections Pursuant to 35 U.S.C. §103

Claims 1-6, 8-11, 13, 15-29, 31-34, 36-37, and 39 are rejected pursuant to 35 U.S.C. §103(a) as being obvious over French Patent No. 2,816,195 of Taylor in view of U.S. Publication No. 2003/0114853 of Burgess et al. The Examiner admits that Taylor fails to teach first and second central portions that are longitudinally slidably matable to one another, but argues that it would have been obvious it add this feature as taught in Burgess to alter the length of the linkage in Taylor.

(1) There is No Motivation to Make the Suggested Modification

One of the requirements for establishing a prima facie case of obviousness is that there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. "The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done." MPEP 2142.

The Examiner has failed to provide the required motivation for making the modification described above to the device disclosed in Taylor. The strongest rational for combining references is a recognition that some advantage of expected beneficial result would be produced by the combination. (See MPEP 2144). There is no advantage to adding the ability for the parts (5, 6) to slide relative to each other as taught in Burgess to the Taylor device because Taylor already discloses a technique for altering the distance between the attachment parts (2) using the oblong opening (15) formed on the parts (5, 6) that make up the cross-piece (1). Thus, altering the distance between the attachment parts (2) is redundant and does not provide any additional advantage.

(2) Modification Changes the Principle of Operation of the Reference

Not only does the suggested modification provide no advantage, but such a modification would change the principle operation of Taylor. As explained in §2143.01(VI) of the *MPEP*, “[i]f the proposed modification or combination of the prior art would change the principle operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.” Taylor is specifically directed to a cross-piece that includes parts (5, 6) that are designed to pivot with respect to one another using the ball and socket joint. In particular, the entire purpose of Taylor’s invention is to provide “a ball and socket joint enabling multidirectional movement of one part of the cross-piece in relation to the other. The cross-piece according to the invention is thus able to accommodate all likely situations, in particular orientations of the shoring rods in different planes.” (Paragraph 0014 of Taylor). The modification suggested by the Examiner requires the principle operation, namely the ball and socket joint, to be eliminated and replaced by a sliding joint. Since a connection between parts (5, 6) that would allow for longitudinal slidable movement would not also allow for multidirectional movement between the parts (5, 6) as provided for with the ball and socket joint, the modification would thus eliminate the principle operation of Taylor, and therefore would not have been obvious.

(3) Taylor Teaches Away from the Proposed Modification

The Examiner has also overlooked the fact that Taylor teaches away from the combination. The Federal Circuit has made it clear that references cannot be combined where references teach away from the combination. *See, e.g., In re Grasselli*, 713 F.2d 731, 743 9Fed. Cir. 1983) (holding that it is improper to combine references where the references teach away from their combination); *see also* M.P.E.P. 2145(X)(D). In paragraphs 3 and 4, Taylor discusses the disadvantages of the prior art, stating that:

These cross-pieces in some cases consist of simple one-piece members, linked to the support rods with an appropriate attachment member. The one-piece members are inconvenient in that they cannot adapt to all situations, in particular not being able to accommodate all the different possible positions of the shoring rods. Especially, the separation

between the support rods may vary from one place to another, or the support rods may be oriented in different planes.

Two-part cross-pieces have been developed that can pivot in one plane in relation to each other. However these cross-pieces only partially remedy the above mentioned problems.

Thus, Taylor specifically addresses the disadvantages of a cross piece like Burgess having two parts that can only pivot in one plane. To overcome what Taylor describes as this drawback of other devices, the parts (5, 6) of the Taylor device are specifically designed to pivot with respect to one another using the ball and socket joint. Accordingly, Taylor teaches away from the modification suggested by the Examiner, and therefore Taylor would not be modified to add the ability for the parts (5, 6) to slide relative to each other, as taught in Burgess.

For all of the above reasons, no person having ordinary skill in the art would modify the parts (5, 6) of Taylor to be longitudinally slidably mated to one another, as taught by Burgess, and therefore claims 1 and 37, and claims 2-6, 8-11, 13, 15-29, 31-34, 36, and 39 which depend therefrom, distinguish over Taylor and Burgess and represent allowable subject matter.

Conclusion

Applicants submit that all pending claims are now in condition for allowance, and allowance thereof is respectfully requested. The Examiner is encouraged to telephone the undersigned attorney for Applicants if such communication is deemed to expedite prosecution of this application.

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Respectfully submitted,



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